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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/590,259

08/18/2006

Yoshihito Kanasashi

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EVEREST INTELLECTUAL PROPERTY LAW GROUP

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EXAMINER

DEXTER, CLARK F

ART UNIT

PAPER NUMBER

3724

MAIL DATE

DELIVERY MODE

07/02/2008

PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b> 10/590,259	<b>Applicant(s)</b> KANASASHI ET AL.	
	<b>Examiner</b> Clark F. Dexter	<b>Art Unit</b> 3724	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 07 May 2008.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-8 is/are pending in the application.
- 4a) Of the above claim(s) 3 and 4 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1, 2 and 5-8 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 18 August 2006 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)            | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)   | Paper No(s)/Mail Date. _____                                      |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>12/6/07</u> .   | 6) <input type="checkbox"/> Other: _____                          |

## **DETAILED ACTION**

### ***Election/Restrictions***

1. Applicant's election without traverse of Group III (claims 1, 2 and 5-8) in the reply filed on May 7, 2008 is acknowledged. Claims 3 and 4 have been withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to a nonelected invention.

### ***Priority***

2. Receipt is acknowledged of papers submitted under 35 U.S.C. 119(a)-(d), which papers have been placed of record in the file.

### ***Information Disclosure Statement***

3. The information disclosure statement filed on December 6, 2007 has been received and the references listed thereon have been considered.

### ***Claim Rejections - 35 USC § 112, 1<sup>st</sup> paragraph***

4. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

5. Claims 1, 2 and 5-8 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter

which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

The specification and drawings do not provide support for the recitation "having a pair of arms rising from both sides of the station" as set forth in claim 1 (line 7) wherein the only "station" set forth refers to the punch station. Rather, it seems that the subject recitation refers to the auxiliary tool station, and thus it seems that the subject recitation should read --having an auxiliary tool station and a pair of arms rising from both sides of the auxiliary tool station--.

***Claim Rejections - 35 USC § 112, 2<sup>nd</sup> paragraph***

6. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

7. Claims 1, 2 and 5-8 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In claim 1, line 7, the recitation "a pair of arms rising from both sides of the station" renders the claim vague and indefinite as to what disclosed structure is being set forth; in line 11, the recitation "is formed" is vague and indefinite as to what it refers.

In claim 2, line 2, the recitation "the operating section of the punching blade" lacks antecedent basis, and it seems that "punching blade" should read --punch--.

In claim 5, line 4, the recitation “punch placed” is vague and indefinite as to what is being set forth, and it seems that “placed” should be deleted.

***Claim Rejections - 35 USC § 102***

8. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

9. Claims 1 and 2 are rejected under 35 U.S.C. 102(b) as being anticipated by Lee, pn 6,089,137.

Lee discloses a device with every structural limitation of the claimed invention including:

a punch (e.g., shown in a detached, raised position in Fig. 8) including a punch station (e.g., 40) formed with a slit into which a sheet to be punched is to be inserted and a guide hole (e.g., through the lower portion of 50 and through 70) for guiding a punching blade in a direction intersecting with the slit, the punching blade to be guided by the guide hole, an operating section (e.g., an upper portion of 56) for operating the punching blade, and a housing (e.g., 60) which accommodates the punch station and the punching blade and which is formed with an opening (e.g., 62) in which the operating section is disposed; and

a punch auxiliary tool (e.g., shown in Fig. 8) having a pair of arms (e.g., the two opposing longitudinally-extending portions of 32) rising from both sides of the station and a pressing operating member (e.g., 10) which is pivotally supported by the arms, wherein an inserting/detaching opening (e.g., shown with arrows in Fig. 8), which is capable of inserting and detaching the punch in such a state that a side where the slit is formed is directed to a side where the pressing operating section is pivotally supported, is formed on the side where the pressing operating section is pivotally supported, a lower surface of the pressing operating member of the punch auxiliary tool is provided with a pressing section (e.g., 14) which presses the operating section inserted from the inserting/detaching opening;

[claim 2] wherein in a state where the operating section of the punching blade is disposed in the opening of the housing, the punch station and the punching blade are accommodated in the housing such that the operating section is substantially flush with an upper surface of the housing (e.g., as shown in Figs. 7 and 8).

### ***Claim Rejections - 35 USC § 103***

10. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

11. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of

the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

12. Claims 5-8 are rejected under 35 U.S.C. 103(a) as being unpatentable over Lee, pn 6,089,137 in view of Mori et al., pn 4,509,397 (hereafter Mori '397).

Lee discloses a device with almost every structural limitation of the claimed invention but lacks the device having a positioning tool and the details thereof. However, such positioning tools are old and well known in the art and provide various well known benefits including holding a workpiece in position relative to a punch tool to prevent or reduce the likelihood of inaccurate punching operations. Mori '397 discloses one example of such a positioning tool as follows:

[claim 5] further comprising a positioning tool (e.g., 2) including a mounting stage (e.g., 27) on which the sheet to be punched is placed, and sheet holding means (e.g., 20) for holding the sheet to be punched placed on the mounting stage, wherein a to-be-retained portion (e.g., including 7) provided on the punch or punch auxiliary tool is engaged with a retaining portion (e.g., 25) provided on the positioning tool, and a punching position in the sheet to be punched is set;

[claim 7 (from 5)] wherein the retaining portion comprises a plurality of the retaining portions (e.g., 25) arranged along the end edge of the mounting stage at equal distances from one another;

[claim 8 (from 7)] wherein a retaining position of the to-be-retained portion which is engaged with the retaining portion can be changed selectively.

Therefore, it would have been obvious to one having ordinary skill in the art to provide such a positioning tool for use with the punching device of Lee, and/or to adapt Lee for use with such a positioning device, to gain the well known benefits including those described above.

Regarding claim 6, the combination of Lee and Mori '397 lacks:

[claim 6 (from 5)] wherein a ruler is mounted on a mounting stage of the positioning tool, the ruler member includes a ruler portion against which an end edge of the sheet to be punched can abut, the ruler member can turn toward its back surface from a position where a surface of the mounting stage is substantially flush, the end edge of the mounting stage which is exposed when the ruler member is turned toward the back surface of the mounting stage is provided with the retaining portion.

However, the Examiner takes Official notice that such ruler devices are old and well known in the art in various forms and provide various well known benefits including providing a workpiece alignment mechanism that provides a visual measure of the workpiece and the portion(s) thereof to be cut. Therefore, it would have been obvious to one having ordinary skill in the art to provide such a ruler device on the device of Lee and Mori '397 to gain the well known benefits including that described above.



***Conclusion***

13. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

14. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Clark F. Dexter whose telephone number is (571)272-4505. The examiner can normally be reached on Mondays, Tuesdays, Thursdays and Fridays.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Boyer D. Ashley can be reached on (571)272-4502. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

**/Clark F. Dexter/  
Primary Examiner, Art Unit 3724**

cf  
June 27, 2008